

REMARKS

Applicant has carefully studied the outstanding Final Office Action. The present Response is intended to be fully responsive to all points of rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of this application are respectfully requested. No new matter has been added by any of the amendments to the specification. Applicant respectfully requests reconsideration and withdrawal of the Examiner's rejections in view of the foregoing amendments and following remarks.

WITHDRAWAL OF FINAL OFFICE ACTION

The Applicant respectfully requests the withdrawal of the Final Office Action. The prior amendment changed the scope of claim 1, but did not change the scope of examination. Claim 1 was amended to incorporate the limitations of claim 2. Therefore, the scope of the examination for claim 1 is the same as the scope of examination for the canceled claim 2. If the Examiner had based the rejection of claim 1 on the same grounds as stated in the first Office Action for rejection of claim 2, then a Final Action would be proper. Rather, the Examiner has abandoned the previous rejections of claim 2 under 35 U.S.C. § 102(b) based on "JP'744" and under 35 U.S.C. § 103(a) based on Marquette in view of Wang. For these reasons, the final rejection is premature. Per MPEP § 706.07(a), a final rejection is proper on a second Office Action "except where the examiner introduces a new ground of rejection that is neither necessitated by Applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)." Here, the new ground of rejection, i.e. § 102(b) based on Delatte, was not necessitated by Applicant's amendment. Rather, the Examiner presumably accepted Applicant's arguments with respect to claim 2 in the prior response and introduced Delatte as a new ground of rejection for the subject matter of claim 1 as amended, i.e. the currently canceled claim 2.

For the foregoing reasons, the Applicant respectfully requests withdrawal of the Final Office Action.

CLAIM REJECTIONS – 35 U.S.C. § 102

Claims 1, 10, 12 & 14

The Examiner has rejected claims 1, 10, 12 & 14 under 35 U.S.C. § 102(b). Specifically the Examiner stated:

Claims 1, 10, 12 & 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Delatte [U.S. Patent No. 4,665,713]. Delatte (figures 1-3) teaches of a storage system comprising: a drawer (5) having a top surface (either a top surface of the bottom panel or a generic top surface [as in a surface above the bottom panel of the drawer] in as much as applicant defines a "top surface"; a frame (4) for accepting a drawer; and a top plate (6) for removably placing over the top surface of the drawer (fig. 1), wherein the top plate has at least one hole (15) for receiving a sample tube (2). The drawer having a face plate (12), the top plate being able to cover some or all of the top surface of the drawer (not figs. 1 & 3), and the drawer having a bottom plate (shown in fig. 2) capable of supporting bottles and/or tubes (fig. 1).

The Examiner cites to Delatte, specifically "grating 6" to show "a top plate for removably placing over the top surface of the drawer, wherein the top plate has at least one hole ..." However, there is no support in the specification of Delatte for the grating to be "removably plac[ed]." Rather, Delatte appears to suggest a permanently affixed grating ("Placed in the ribs 14 of each of the two drawers is the corresponding grating 6" (Col. 2, ll. 32-33)). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Here, Delatte fails to show a removable top plate as contained in the present claim 1. Accordingly, the Applicant respectfully requests reconsideration of the rejection. Upon withdrawal of the rejection, the Applicant believes the claims would be in condition for allowance.

CLAIM REJECTIONS – 35 U.S.C. § 103

Claims 3-4

The Examiner has rejected claims 3-4 under 35 U.S.C. 103(a) as being unpatentable over Delatte in view of Wang. Specifically, the Examiner stated:

Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Delatte in view of Wang [U.S. Patent No. 4,895,650]. Delatte teaches applicant's inventive claimed structure as disclosed above, but does not show a removable insert associated with the storage system. Wang (figures 1-4a) is cited as an evidence

reference to show the known use of removable insert (152a) within a top plate having holes in a storage system. The system being used to support tubes. Accordingly, the position is taken that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the storage system of Delatte by incorporating a removable insert within the at least one hole as taught by Wang because this arrangement would provide Delatte with a means to securely hold the tubes within the apertured top plate enabling the tube to be firmly grasped thereby allowing the drawer to be tilted or inverted without the tubes sliding out of the drawer (note col. 2).

Subject to the aforementioned arguments with respect to Delatte failing to teach every limitation of independent claim 1, the Applicant traverses the rejection and respectfully requests the Examiner to withdraw the rejection directed to claims 3 and 4. In making an obviousness rejection, the Examiner must establish a prima facie case of obviousness which requires a showing of three criteria:

“First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).” MPEP § 2142

After careful examination of the Wang reference with respect to the present invention, the Applicant asserts the Wang reference fails to teach “a removable insert.” It is clear in Wang that the “insert” identified by the Examiner in figures as elements 152a – 157a are “aperture inserts” which, in combination with aperture 52a, “comprise a means for accepting and holding a container such as a test tube 252a. However, Wang fails to teach a “removable insert.” One aspect of the present claimed invention is that the removable inserts allow the use of tubes of varying diameters. In Wang, it is believed the tubes intended for use were all of a single, standard diameter. As such, there is no support, neither implicit nor expressly stated, that the inserts as disclosed by Wang would have been removable. Indeed, the sole function of the Wang “inserts” is to hold the tubes in position if the rack is “inverted or tilted.” If the inserts of Wang were removable, the likelihood of the inserts maintaining the tubes in position when “inverted or tilted” would be substantially compromised. For these reasons, it is clear to the Applicant that the Wang reference necessarily requires permanently positioned “aperture inserts.” As such, in

view of the Wang and Delatte references, the present invention would not be obvious to a person of ordinary skill in the art, because Wang and Delatte fail to disclose at least two limitations of the present invention.

The Applicant respectfully requests withdrawal of the rejection in view of the presented justification for the novelty of the present invention.

Claim 11

The Examiner has rejected claim 11 under 35 U.S.C. 103(a) as being unpatentable over Delatte in view of Woodruff. Specifically, the Examiner stated:

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Delatte in view of Woodruff [U.S. Patent No. 731,330]. Delatte teaches applicant's inventive claimed structure as disclosed above, but does not show the drawer as having a "card holder". Woodruff (figures 1-8 is cited as an evidence reference to show the known use of a card holder (H) on a faceplate of a drawer. Accordingly, the position is taken that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the storage system of Delatte by incorporating a card holder on the drawer as taught by Woodruff because this arrangement would provide Delatte with a means to clearly identify the drawer itself or to identify contents associated with or located within the drawer as is conventionally known in the art.

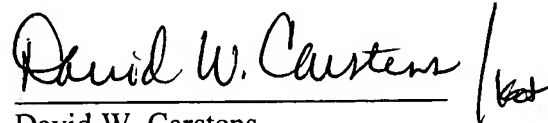
The Applicant agrees that Woodruff clearly shows a card holder on a drawer. However, in light of the aforementioned arguments that claim 1, on which claim 11 depends, is new and novel considering the Delatte disclosure, the Examiner's argument with respect to claim 11 is now moot. The Applicant respectfully requests the withdrawal of the rejection.

CONCLUSION

It is respectfully urged that the subject application is patentable over references cited by Examiner and is now in condition for allowance. Applicant requests consideration of the application and allowance of the claims. A set of claims as they have been previously amended are included with this response. If there are any outstanding issues that the Examiner feels may be resolved by way of a telephone conference, the Examiner is cordially invited to contact David W. Carstens at 972.367.2001.

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Respectfully submitted,



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